Appl. No. 09/822,735
Amdt. Dated 1-9-2006
Reply to Non-Final Office Action of 10-7-2005

REMARKS/ARGUMENTS

Claims 1-30 are pending in the present application.

This response is to respond the non-final Office Action mailed October 7, 2005. In the non-final Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

1. <u>Claims 1-3, 5-13, 15-3, and 25-30:</u>

In the Office Action, the Examiner rejected claims 1-3, 5-13, 15-3, and 25-30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0081027A1 by Chatterjee et al. ("<u>Chatterjee 1</u>"), U.S. Patent No. 6,549,675 issued to Chatterjee ("<u>Chatterjee 2</u>") and U.S. Patent No. 6,847,365 issued to issued to Miller et al. ("<u>Miller</u>") in view of U.S. Patent No. 6,697,352 issued to Ludwig et al. ("<u>Ludwig</u>"). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004)*. Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

<u>Chatterjee 1</u> discloses a method for electronic transport of digital ink. An image is formatted into a digital ink structure format (<u>Chatterjee 1</u>, paragraph [0018]. Then, the message is encoded into printable characters, such as ASCII characters (<u>Chatterjee 1</u>, paragraph [0018]). In the decoding process, each character is mapped to its 6 bit counterpart and the mapped result is concatenated to the partially decoded compressed data stream (<u>Chatterjee 1</u>, paragraph [0023]).

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Chatterjee 2 discloses compression of digital ink.   As a user writes on a touch-screen display, the X-axis and Y-axis coordinate values of points are provided (Chatterjee 2, col. 5, lines 6-10). A digital processor 26 separates these values into two arrays (Chatterjee 2, col. 5, lines 6-10). A difference analyzer 28 computes the offset between consecutive points (Chatterjee 2, col. 5, lines 54-55). A Huffman encoder uses histogram of the occurrences o the second order differences for the X-axis and Y-axis data (Chatterjee 2, col. 6, lines 32-37). A bitstream processor 32 encapsulates the compressed bitstream into a data frame (Chatterjee 2, col. 5, lines 45-48). Chatterhee 2 claims a device that includes a bitstream processor that encapsulates the encoded bitstream into a data packet for transmitting to a remote computer (Chatterjee 2, col. 16, lines 14-16).

Ludwig discloses communication device and method. The implementation of a protocol that embeds packets is made sensitive to the type of data being embedded (Ludwig, Abstract). An IP datagram is passed to the link layer, where a header associated with the link layer protocol (LLP), e.g. the Point-to-Point Protocol (PPP), is added. The resulting packet is often called a frame (Ludwig, col. 2, lines 24-27).   PPP is used to transport multiple protocols, such as IP, LCP (link control protocol), PAP (password authentication protocol) etc. simultaneously over a serial link. A PPP protocol identifier identifies which protocol data unit (PDU) or protocol packet is contained in a particular PPP packet. IP, which in turn is carried by PPP, can carry packets of multiple protocols, namely TCP, UDP and ICMP (Internet Control Message Protocol), which are also distinguished by a protocol identifier in the IP header (Ludwig, col. 6, lines 45-65).

Miller discloses systems and methods for efficient processing of multimedia data. A media processor 32 includes media processing elements MPEs 66, 68, 70 and 72 (Miller, col. 6, lines 31-34).   The MPEs 66 – 72 are configured to decode or decompress audio and video portions of a MPEG-2 data stream, or to process sub-picture, menu, navigation and other video and audio control functions for a TV or a computer monitor. (Miller, col. 7, lines 56-62; col. 8, lines 14-17).

Chatterjee 1, Chatterjee 2, Ludwig, and Miller, taken alone or in any combination, do not disclose, either expressly or inherently, at least one of (1) a management layer to process data using a processing function; (2) the processing function is enabled or disabled by a configuration user interface; (3) a packetizer to packetize the string of data into at least one packet having a

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header identifying the first format as recited in claims 1, 8, 11, 18, 21, and 28; and (4) a detector to detect the second format as recited in claims 2, 12, and 22.

Chatterjee 1 merely discloses formatting, compressing, and encoding. No packetizing is performed. Furthermore, the compressed digital ink stream includes a header and a compressed digital ink message (Chatterjee 1, paragraph [0028]). The header, therefore, is produced during the compressing, before the encoding. In contrast, the claimed invention provides the header during packetizing after the encoding. In addition, Chatterjee 1 does not disclose that the header identifying the first format. Regarding claims 2, 12, and 22, Chatterjee 1 does not disclose detecting the second format. Chatterjee 1 merely discloses checking for a place keeper/end of message character (Chatterjee 1, paragraph [0023]), not detecting a second format.

Chatterjee 2 merely discloses encoding the second order differences of the X-axis and Y-axis data and encapsulating the encoded bitstream into a data packet. There are no two different formats.

The Examiner states that Chatterjee 1 and Chatterjee 2 do not disclose a management layer to process data in a first format using a processing function that is enabled or disabled by a configuration user interface (Office Action, page 3). However, the Examiner does not identify the management layer and/or the configuration user interface in any one of Ludwig and Miller. Therefore, the combination of Chatterjee 1, Chatterjee 2, Ludwig, and Miller is improper.

The Examiner further states that Ludwig teaches a system for processing data of more than one format. Applicants respectfully disagree. Ludwig merely discloses the PPP is used to transport multiple protocols. These protocols are used for packet transmission, not used for encoding data into a string of data.

The Examiner further states that by selectively configuring one of the MPEs, Miller was able to sue the same infrastructure to support multiple formats (Office Action, page 4). Applicants respectfully disagree. The MPEs are configured to decode or decompress MPEG-2 stream or process subpicture for display on TV or a computer monitor, not to encode data into a string of data. Decoding and decompression are not encoding. In fact, they are the opposite of encoding.

Accordingly, Applicants believe that claims 1-3, 5-13, 15-3, and 25-30 and distinguishable from the cited prior art references.

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2. Claims 4, 14, and 24:

In the Office Action, the Examiner rejected claims 4, 14, and 24 under 35 U.S.C. §103(a) as being unpatentable over Chatterjee, Ludwig, and Miller as applied to claims 1-3, 5-13, 15-23, and 25-30 above, and further in view of U.S. Patent No. 6,741,749 issued to Herbert, Jr. ("Herbert"). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of obviousness.

Chatterjee 1 discloses a method for electronic transport of digital ink as discussed above. Chatterjee 2 discloses compression of digital ink as discussed above. Ludwig discloses a communication device and method as discussed above. Miller discloses a systems and methods for efficient processing of multimedia data.

Herbert discloses a system device, computer program product, and method for representing a plurality of electronic ink data points. Pen-enabled computing systems capture handwriting input. The handwritten information may be bodily incorporated into messages, such as email messages, facsimiles, instant messages and the like (Herbert, col. 5, lines 1-5).

Chatterjee 1, Chatterjee 2, Ludwig, Miller and Herbert, taken alone or in any combination, do not disclose, suggest, or render obvious (1) a management layer to process data using a processing function; (2) the processing function is enabled or disabled by a configuration user interface; (3) a packetizer to packetize the string of data into at least one packet having a header identifying the first format as recited in claims 1, 8, 11, 18, 21, and 28; and (4) a detector to detect the second format as recited in claims 2, 12, and 22, and (5) a network having an instant messaging infrastructure as recited in claims 4, 14, and 24. There is no motivation to combine Chatterjee 1, Chatterjee 2, Ludwig, Miller and Herbert because none of them addresses the problem of transmitting new data format under existing infrastructure. There is no teaching or suggestion that a packet transmitted to a network having an instant messaging infrastructure is present. Chatterjee 1 and Chatterjee 2, read as a whole, do not suggest the desirability of an instant message infrastructure.

None of Chatterjee 1, Chatterjee 2, Ludwig, and Miller discloses or suggests packetizing the string of data, a management layer, a processing function which may be enabled/disabled using a configuration user interface as discussed above. Herbert merely discloses representing a

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series of electronic ink data points to reduce the storage capacity (Herbert, col. 5, lines 24-27), not encoding data in a first format into a string of data in the second format.

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. Here, Chatterjee 1 discloses inserting the encoded digital ink segment in an email message (Chatterjee 1, paragraph [0022]). The encoded message uses ASCII characters. In contrast, Herbert discloses representing the plurality of data points by high-order derivatives (Herbert, col. 9, lines 11-13). Modifying Chatterjee 1 to incorporate the teaching of Herbert implies that the message must be encoded by high-order derivatives which are incompatible with ASCII text message. Therefore, it cannot be inserted in an email message, rendering Chatterjee 1's invention being unsatisfactory for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. Hodosh v. Block Drug Col, Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan,

confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills 916 F.2d at 682, 16 USPQ2d at 1432; In re Fitch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Here, none of the cited prior art references discloses, suggests, or renders obvious the above elements. Accordingly, the combination of Chatterjee 1, Chatterjee 2, Ludwig, Miller and Herbert to reject the claims is improper.

Therefore, Applicants believe that independent claims 1, 8, 11, 18, 21, 28 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §103(a) be withdrawn.

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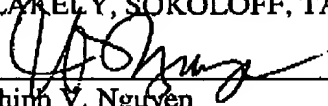Reply to Non-Final Office Action of 10-7-2005

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: January 9, 2006   By _____

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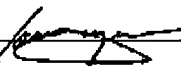**MAILING**   **FACSIMILE**

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